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IN THE

Supreme Court of the United States

October Term, 1962

No. 402

SOLO PRODUCTS CORPORATION,

Petitioner,

—v.—

FEATHERCOMBS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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September 5, 1962

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SOLO PRODUCTS CORPORATION,

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—v.—

FEATHERCOMBS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioner prays that a writ of certiorari be issued to review the judgment of the United States Court of Appeals for the Second Circuit, entered July 13, 1962, which modified a judgment of the United States District Court for the Southern District of New York, entered June 30, 1961 (Judge Metzner).

Opinions Below

The opinion of the Court of Appeals for the Second Circuit has not yet been reported officially and is reported at 134 U. S. P. Q. 209 (1962), and is annexed hereto as *Appendix A*. The Findings of Fact and Conclusions of Law of the District Court for the Southern District of New York were not officially reported and appear at S17.*

* "(S—)" refers to Solo's appendix below.

The opinion of the District Court is reported at 196 F. Supp. 299 (1961) and appears at S6.

Jurisdiction

The judgment of the Court of Appeals for the Second Circuit was entered on July 13, 1962 (*Appendix B* to this petition). The Order of the Court of Appeals, dated July 25, 1962, denying a request of Petitioner for an extension of time to file a petition for rehearing is *Appendix C* annexed hereto. The Order dated August 6, 1962, staying the issuance of the mandate of the Court of Appeals for a period of 30 days is *Appendix D* annexed hereto.

Jurisdiction of this Court is invoked under Section 1254(1) of Title 28 of the United States Code and under Section 1122 of Title 15 of the United States Code.

Questions Presented

1. May a Court of Appeals hold a patent invalid over a prior art patent not in the record?

2. May the term "Feathercombs" be held to be a valid trademark for "retainers and combs for hair and decorative hair retainers" and infringed by the use of the term "Featherlight" for hair retainers, where the term "Featherlight" had been in use continuously on hair retainers (curlers, clips, and rollers) for 15 years before use of the term "Featherombs"?

3. May use of the word "Featherlight" be held to be a trademark usage when used alone ("Featherlight" combs), and be held descriptive when preceded by the corporate

name of Petitioner ("Solo Featherlight" combs), and a registration thereof ordered canceled from the Patent Office register?

Statutes Involved

This case involves the following statutes (*Appendix E* to this petition):

1. Section 282 of the Patent Act of July 19, 1952, 66 Stat. 792, 35 U. S. C. Sec. 282.

2. Trademark Act of 1946 (Lanham Act), Sections 2d, 23 and 26; 15 U. S. C. Sections 1052(d), 1091 and 1094.

Statement of the Case

Two cases were consolidated for trial.

In the first case Featherombs sued Solo for infringement of two Smith patents, for infringement of its trademark "Featherombs" for "retainers and combs for hair and decorative hair retainers" (page 27a herein), and for unfair competition. Solo counterclaimed for infringement of its trademark "Featherlight" (S120). In the second case Solo sued Featherombs for infringement of its Weeks patent (S128).

Solo has been in the field of manufacturing items for use in women's hair continuously since 1925. It has sold combs, rollers, curlers, wavers, clips, bobby pins and hairnets continuously since at least as early as 1940.

Solo has used the term "Featherlight" continuously from 1938 to the present on a variety of hair retaining devices as follows:

	Beginning date	
"Solo Featherlight" Curlers	1938	(Ex. BM; S74)
"Solo Featherlight" Rollers	1938	(Exs. BM, CD; S73, 125)
"Featherlight" Wave Clips	1946	(Ex. CA; S93, 124)
~~"Featherlight"~~ "Featherlight" Combs	1957	(Ex. 18)
"Featherlight" Combs	1957	(Exs. CC, CD, 19, 29)
"Solo Featherlight" Combs	1957	(Exs. CE, CF, DG, CH; S33-4, 94-5)

Solo used the term "Featherlight" alone (Exs. BR, CA, CC, CD, 18, 19, 29) and in combination with its corporate name and house mark "Solo" (Exs. CB, CE, CF, CG, CH), in connection with hair retaining devices long before and after Featherombs first began doing business in 1953.

Solo has listed "Featherlight" as its trademark for hair rollers since the end of World War II in every annual directory edition of the three recognized trade publications (S89-90). These directories list every trademark and every manufacturer in the notion business (S88).

Solo's Weeks patent is for a universally flexible comb, having a capacity to bend and twist freely in any direction and in any plane.

Featherombs' *second* Smith patent was rejected by the Patent Office on the Weeks patent, and allowed on *ex parte* affidavits of invention by Smith before Weeks' filing date (*Milburn v. Davis-Bournonville*, 270 U. S. 390 (1926), now 35 U. S. C. 102(e). At the trial priority was conceded to Weeks (S48).

All the prior art introduced in evidence and discussed by witnesses showed combs having continuous, nonexpansible spines or backs from which the teeth extended. Each of the prior art combs used against the Weeks patent, as the Trial Court found, "cannot be expanded or contracted along its top axis nor can it be bent nor twisted freely in any direction and in any plane because of the rigid top".

The Trial Court held the Weeks patent invalid over the Sawyer patent No. 1,684,362 (S131) and Coakley British patent No. 448,562 (S134). Both of the Smith patents were held invalid. The Court of Appeals, after noting that Sawyer and Coakley were "hampered in flexibility" because of "fairly rigid backing" held the Weeks patent invalid over a Rheinberg patent of which it took "judicial notice" (footnote 1, page 4a herein). This patent was attached to Feathercombs' answering brief in the Court of Appeals, with no prior notice given Solo. It was not offered in evidence, marked for identification, or mentioned, at the trial.

The Court of Appeals affirmed Judge Metzner in holding "Featherlight" to be descriptive of the characteristics of hair accessory items and used descriptively when combined with Solo's main mark "Solo"; and held that "Featherlight" became a trademark in 1957 because Solo used it alone and not in combination with "Solo".

This trademark usage was held to infringe Feathercombs' trademark "Feathercombs".

Reasons for Granting the Writ

1. The Court of Appeals held the Weeks patent invalid over a patent which was not in evidence and was never considered or seen by the Trial Court. This violates 35 U. S. C. 282, decisions of this Court and of the

Courts of Appeals for the Fifth and Ninth Circuits, and orderly judicial procedure.

2. The basic issues of trademark law in this case were decided by the Courts below in a way which conflicts with the Trademark Act of 1946, with controlling decisions of this Court, and with decisions of other Circuit Courts of Appeals.

ARGUMENT

1. The decision of the Court below taking judicial notice of a patent not in the record is repugnant to the purpose, intent and meaning of the Patent Act (35 U. S. C. 282), is at variance with decisions of this Court, is in conflict with decisions of other Circuits, and violates orderly judicial procedure.

The Weeks patent satisfied all the conditions of the Patent Act and was duly issued. It is presumed valid (35 U. S. C. 282). A patent is a creature of statute law, *Crown Die and Tool Co.* v. *Nye Tool and Machine Works*, 261 U. S. 24; 67 L. ed. 516 (1922). The rights acquired in a patent cannot be set aside unless authorized by statute and in the manner the statute prescribes, see *Gayler* v. *Wilder*, 10 How. 477, 494; 13 L. ed. 504, 511 (1850). As this Court said in *United States* v. *American Bell Telephone Co.*, 167 U. S. 224 (1897) at page 247:

> "A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural, but of purely statutory right."

35 U. S. C. 282 says that a party asserting invalidity "shall give notice" and that "In the absence of such notice

proof of the said matters may not be made at the trial except on such terms as the court requires."

In *Thermo King Corp. v. White's Trucking Service*, 292 F. 2d 668 (5th Cir. 1961) the Court of Appeals in a lengthy and detailed opinion reversed a judgment in a patent case denying the patentee relief where the Trial Court admitted patents and publications without prior notice. Judge Brown reviewed the history, purpose, and interpretation of the statute. He said, beginning on page 673:

> "Section 282 is an extension of former §69, formerly R. S. §4920, and traces its origin actually back to the Patent Act of 1790. Liquidometer Corporation v. Capital Airlines, Inc., D. C. D. Del. 1959, 24 F. R. D. 319, 321. About one predecessor statute, §15 of the Patent Act of 1836, Justice Story had this to say: 'The object of this most salutary provision is to prevent patentees being surprised at the trial of the cause by evidence of a nature which they could not be presumed to know, or be prepared to meet, and thereby to subject them either to most expensive delay, or to a loss of their cause. * * *' Philadelphia & Trenton R. Co. v. Stimpson, 1840, 14 Pet. 448, 459, 39 U. S. 448, 459, 10 L. Ed. 535.
>
> "[4] Intervening events have perhaps been a transfusion to restore full vigor to it. After the adoption of the Federal Rules of Civil Procedure in 1938, many courts held that the discovery rules superseded §69. Liquidometer Corporation v. Capital Airlines, Inc., D. C., 24 F. R. D. 319, 321 and note 4. But by the Patent Act of 1952, Congress deliberately intended to revive the statute as an effective regulation of patent trial procedure. The result is that the statute and the Federal Rules on discovery now coexist. The one does

not exclude or supersede the other. The statute, subject always, of course, to the discretion reserved to the court to allow matters not specified in a notice to be received on such terms as the court requires, operates as a minimum. Liquidometer Corporation v. Capital Airlines, Inc., supra, 24 F. R. D. 319, at page 323.

"In its deliberate re-enactment, the additions to the statute reflect an increased, not lessened, importance in its application. As re-enacted it covers both the defenses of invalidity and non-infringement. It was also expanded to cover not only directly anticipatory prior art references, but also prior art references to show the state of the art.

"[5] This statute, just as interrogatories, requests for admissions, and the like under the Rules, is intended to do more than alert an adversary to the existence of evidence. It enables the plaintiff to know what sort of defense is going to be asserted. In a very real sense it determines what is to be tried. It has like value to the court either in trial or in the management of the serious administrative problems in determining what cases are ready for trial and capable of being submitted within the available time. The nature of patent litigation makes this of unusual importance. Judges trained in the law are confronted with baffling devices applying esoteric principles of all branches of higher mathematics and science. Long before the current interest in demonstrative evidence as it is sometimes used (or misused) in damage suits, the patent bar, with its generally high state of professional competence and extraordinary thoroughness in preparation, has found helpful ways to make the

judges' task manageable and intelligible. Large multi-colored elaborate charts, diagrams, models and other exhibits, oftentimes costly and complicated, are prepared. They are used both on examination and serve with unusual effectiveness in cross-examination of experts and others skilled in the particular field. To the problem of understanding the substantive nature of the patented device or method may be added the further, if not more basic, one of communication: just what do these words—often a long, prolix combination with a liberal sprinkling of adverbs and almost no punctuation—of this claim mean? It is seldom safe to be a literalist. Bryan v. Sid W. Richardson, Inc., 5 Cir., 1958, 254 F. 2d 191, 192. The meaning generally calls for a search into the practical considerations of the particular art. Inglett & Co., Inc. v. Everglades Fertilizer Co., 5 Cir., 1958, 255 F. 2d 342, 347-48. This is a necessary consequence of the handy apothegm that a patentee is his own grammarian and lexicographer. And all of this naturally leads to the use of experts who, matching element by element, either as between the accused device and the patent, or as between the patent in suit and those asserted to anticipate, undertake to translate the problem into understandable, tangible, specific terms for the judge.

"This whole search for truth in a specialized field where matters seldom turn on credibility in its cruder sense—who is telling the unvarnished truth?—is impeded unless the adversaries are fully prepared. Preparation, quite obviously, requires knowledge of what principal, specific, factual issues are to be examined."

In *Creamelle Co. v. Merlino*, 289 F. 2d, 569 (9th Cir. 1961), the Court of Appeals refused to consider evidence not submitted to the Trial Court even though it was al-

leged to have been "newly discovered". The Court stated that the proper procedure to follow to introduce the evidence was to file a motion in the District Court under Rule 60 F. R. C. P.

The Court of Appeals in refusing to consider this evidence said at p. 570:

> "To add them to the present record on appeal in this court would hardly be appropriate in view of the fact that our action on appeal can properly be based only upon a record considered by the trial court."

Even under Rule 60 F. R. C. P. which expressly allows the Trial Court after trial to review evidence not previously introduced there must be a showing that the evidence is "newly discovered which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b)". No such showing was made by Feathercombs or could be made here.

In *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, 16-17; 83 L. ed. 1071, 1079 (1938), this Court reviewed the defense of abandonment not raised in the courts below. This Court analyzed Rev. Stat. 4920, which is the predecessor of 35 U. S. C. 282 of the present Patent Act. The Court noted abandonment was set forth in Rev. Stat. 4920 as an affirmative defense and must be pleaded and proved. This defense was never raised below allegedly for lack of prior knowledge. The Court refused to consider this defense *de novo*, saying (p. 16):

> "If the defense had been pleaded originally or by amendment the respondents would have had an opportunity to meet it by proof and this they appear not to have been afforded."

2. The basic issues of trademark law in this case were decided by the Courts below in a way which conflicts with the Trademark Act of 1946, with controlling decisions of this Court, and with decisions of other Circuit Courts of Appeals.

The decisions below holding Featherecombs' earlier registered but later used trademark "Featherecombs" valid and infringed by the confusingly similar mark "Featherlight" was contrary to the specific mandate and purpose of the Trademark Act of 1946.

Section 2(d) of the Trademark Act of 1946 (15 U. S. C. 1052(d)), Appendix E herein, states:

> "No trademark * * * shall be refused registration * * * unless it—
>
> (d) Consists of or comprises a mark which so resembles * * * a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers."

The Congressional purpose and intent with respect to the Trademark Act of 1946 is shown by House Committee Report No. 944, 76th Congress, which in reporting favorably the then pending trademark bill said:

> "To protect trademarks, i.e., marks which permit the goods of different makers to be distinguished from each other, is to promote competition and is sound public policy."

The record is uncontradicted that Solo used "Featherlight" alone and in combination with its house mark "Solo" for 7 and 15 years respectively before Featherecombs' first

use on the identical class of goods, hair retainers (S70, 93, 124, 125). Since the mark "Featherecombs" "so resembles a mark", "Featherlight", "previously used in the United States by another and not abandoned, as to be likely to cause confusion", its federal registration is contrary to the Trademark Act. Therefore, the Featherecombs' registration was void.

It is apparent that the decisions below incorrectly applied the basic criteria of registrability prescribed by the Federal Trademark Act of 1946.

Also, the test of infringement as applied by the Court below is in conflict with decisions of the other Circuit Courts of Appeals.

The Court below held "Featherlight" infringed "Featherecombs" because Solo intended that "Featherlight" be a trademark.

The test in the Fifth Circuit as stated in *Ahrumson* v. *Coro, Inc.*, 240 F. 2d 854 (5th Cir. 1957), is that the infringer must be the one later to adopt the term alleged to be infringing. If this test were applied to "Featherlight", there could be no infringing use.

Similarly, the Seventh Circuit held that for infringement of a trademark, the infringer must "adopt" the confusingly similar term on related goods after prior use of the trademark, *National Van Lines, Inc.* v. *Dean*, 288 F. 2d 5 (7th Cir. 1961).

Solo had adopted "Featherlight" in 1938 (S70), fifteen years before Featherecombs was formed. All Solo did was to continue to use "Featherlight" in 1957 in the same manner and style and on the same goods, hair retainers, that it did since 1946 (S124, 125).

The Courts below held petitioner's use of "Featherlight" alone, i.e., "Featherlight Combs", to be a trademark usage, not descriptive, which they enjoined, but to be descriptive and not a trademark usage when combined with petitioner's tradename "Solo" as "Solo Featherlight Combs". Therefore, it is only by reason of the combined usage of "Featherlight" with petitioner's corporate name or housemark "Solo" that the trademark "Featherlight" becomes descriptive in the Courts' views.

Both Courts found petitioner used "Featherlight" at least fifteen years prior to respondent's first use of "Featherecombs" (5a, S27 No. 51).

Since Solo's registration No. 675,387 (S120) was ordered stricken because of Featherecombs' earlier filed registration, Solo is denied the benefits and rights provided under the Trademark Act of 1946, because Solo's earlier use was in combination with its principal or house mark "Solo".

In the phrase "Wrigley Spearmint Gum", Wrigley is the trademark. "Spearmint" has been held by the Seventh Circuit "to be a common noun denoting flavor", *L. P. Larson, Jr. Co. v. William Wrigley, Jr. Co.*, 253 Fed. 914, 915 (7th Cir. 1918).

If Wrigley used the term "Spearmint Gum", not preceded by its corporate mark "Wrigley", in accordance with the decision below "Spearmint" would become a trademark.

Turning pages in any newspaper or magazine, will show the importance of this concept of using house and product marks together and that it is accepted practice for manufacturers to use product or secondary marks—e.g., "Dacron", "Victor", "Loving Care", "Elsie", "Kraft", and "Sealtest", in combination with their primary or house marks, i.e., "Du Pont", "RCA", "Clairol", "Borden's" and "National Dairy", respectively. Also Ford Falcon, Ford Thun-

derbird, Plymouth Valiant (Chrysler), Oldsmobile 98 or F85 (General Motors), Lincoln Continental (Ford), Douglas DC-8, Boeing B-707, American Astrojet, and Sears Cold-Spot, Silvertone, Dunlap and Kenmore are further examples.

The Court of Customs and Patent Appeals in *Burton-Dixie Corp.* v. *Rustonic Corp.*, 43 C. C. P. A. 950, 234 F. 2d 668 (C. C. P. A. 1961) noted at page 670 that:

> "It is not uncommon for a manufacturer to use more than one mark on his goods, and to vary the emphasis placed on various marks, to change the way in which a mark is used, or to discontinue it altogether."

The decisions below represent such a sharp departure from the great weight of authority of combination house and product marks as to call for corrective action by this Court. A failure to act in this case will cause great confusion in this field.

The mischief that would result if the decision below were followed and a trademark becomes descriptive merely because it is used in combination with a house or principal mark, is evident. Would a mark which is rendered descriptive because it is used in combination with a house mark be completely destroyed as a trademark, or, if the mark is later used alone as an adjective does it revert back to a valid trademark? The decision below appears to hold this.

Must large companies, like du Pont, General Motors, General Electric or Solo be restricted to a single house mark ("du Pont") without a subsidiary mark, to get the benefits of the Lanham Act? Or if not, must they omit their house marks in order to establish a valid secondary mark? Or be subjected to a double standard with respect to descriptiveness if they do not omit their house mark? These questions and many others will all have to be an-

swered through extensive and burdensome litigation if the decision below is allowed to stand.

Even if the holding below that "Featherlight" is descriptive is accepted, the holding that the descriptive term "Featherlight" infringed "Featherecombs" is contrary to holdings of the Third and Ninth Circuits.

Both of these Circuits have held that descriptive terms previously used before adoption of the alleged infringed trademark could not infringe the trademark. *Flintkote Co.* v. *Tizer*, 266 F. 2d 849, 852 (3d Cir. 1959); *Rohr Aircraft Corp.* v. *Rubber Teck, Inc.*, 266 F. 2d 613, 621-23 (9th Cir. 1959).

The Court below in awarding Featherecombs its damages and Solo's profits, for Solo's infringement of the "Featherecombs" mark conflicts with applicable decisions of this Court and the Court of Appeals for the Seventh Circuit.

Solo's acts were not wantonly and intentionally fraudulent. Solo's honest belief that "Featherlight" was its trademark is shown by its registration of "Featherlight" as its trademark in all of the trade journals more than five years before Featherecombs' first use of its mark.

The award of profits and damages to Featherecombs conflicts with the principles set forth by this Court in *Champion Spark Plug Co.* v. *Sanders*, 1947, 331 U. S. 125, 91 L. Ed. 1386 (1947); *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U. S. 203, 86 L. Ed. 1381 (1942) and *Saxlehner* v. *Siegel-Cooper Co.*, 179 U. S. 42, 45 L. Ed. 77 (1900).

Further, the decision below conflicts with the decision of the *Fuller Brush Company* v. *Fuller Products Co.*, 299 F. 2d 772 (7th Cir. 1962), in which the Court of Appeals for the Seventh Circuit reversed the District Court's award of

an accounting of profits to the successful plaintiff in a trademark infringement action.

The petitioner believes the effects of the decision of the Court of Appeals to be far reaching. It believes that important questions are presented and that the answers given by the various Circuits are in conflict. It urges this Court to resolve this question by exercising its power of supervision.

Since this Court so rarely accepts a trademark case for review, its old precedents are out of line with the current state of the law as it has developed in the lower federal courts to meet the complex needs of a constantly growing economy. It is of the utmost commercial importance that the Court deal with the substantive issues of trademark law under the Act of 1946, which have not had the benefit of any elucidation whatever by the Supreme Court. Only this Court can dispel the confusion which now prevails, to the lasting injury of the business community and the consuming public.

CONCLUSION

For the foregoing reasons the petition for writ of certiorari should be granted.

Respectfully submitted,

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Sept. 5, 1962.

APPENDIX A

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 378—September Term, 1961.

(Argued June 12, 1962 . Decided July 13, 1962.)

Docket No. 27534

FEATHERCOMBS, INC.,

Plaintiff-Appellee-Cross-Appellant,

—against—

SOLO PRODUCTS CORPORATION,

Defendant-Appellant-Cross-Appellee.

SOLO PRODUCTS CORPORATION,

Plaintiff-Appellant,

—against—

FEATHERCOMBS, INC.,

Defendant-Appellee.

Before:

FRIENDLY, KAUFMAN and HAYS,

Circuit Judges.

Appeal from a permanent injunction for trademark infringement and unfair competition entered in a consolidated action, United States District Court for the Southern

Appendix A

District of New York, Metzner, *J.*, reported in 196 F. Supp. 299 (1961). Affirmed as modified.

JOHN B. CUNNINGHAM, GERALD W. GRIFFIN, New York, N. Y. (Cooper, Dunham, Dearborn & Henninger, R. Bradlee Boal, New York, N. Y., of counsel), *for Feathercombs, Inc.*

FLOYD H. CREWS, New York, N. Y. (Darby & Darby, Howard C. Miskin, New York, N. Y., of counsel), *for Solo Products Corp.*

KAUFMAN, *Circuit Judge*:

This case comes before us on cross-appeals from a judgment involving issues of patent validity, trademark infringement, and unfair competition. In the first of two consolidated actions brought in the District Court, Feathercombs, Inc. (hereafter referred to as Feathercombs), sued Solo Products Corporation (hereafter referred to as Solo), a competitor in the field of ladies' hair appliances, more particularly ladies' hair-retaining combs, for (a) infringement of its patent on a flexible, expandable comb, (b) infringement of its registered mark "Feathercombs," and (c) for unfair competition arising from the advertising and marketing of Solo's similar product, the Solo "Featherlight" comb. Solo counterclaimed for infringement of its own registered trademark "Featherlight," and in a second action sued Feathercombs for infringement of its patent on a flexible, hair-retaining comb—a patent which, concededly, was procured before the Feathercombs patent considered in the first case. It was held in the court below that the patents owned by both parties were invalid because they had been anticipated by the prior art. But the court

found that Solo was liable for trademark infringement and unfair competition; and, as a result, the "Featherlight" registration was cancelled, Solo was enjoined from continuing certain deceptive packaging and display techniques, and Solo was also held liable for damages and profits which would be determined by a special master on an accounting.

I.

As we have already noted, the parties before us are competitively engaged in the manufacture and marketing of comb-like devices for the retention of women's hair. These devices are capable of unusual pliability because of gripping metal or wire teeth which are joined one to the next rather than all to a rigid bar or wire top. Because of this, the combs may be used to retain the hair in any number of styles while remaining invisible to the eye. Although difficult to describe in words, the devices resemble a series of inverted hairpins connected to one another, the bottom of each pin being pinched together for insertion into the hair, and the top being an arch leading into the next identical member. The arch between each member creates a spring-tensioned connection, so that the entire "comb" may be expanded or contracted, and variously shaped.

Feathercombs lays claim to this device under a patent granted in 1954 to its president, Roy A. Smith. The court below held the Smith patent invalid because it was anticipated by earlier patented hair-retaining devices, especially the Sawyer patent (1928), the Coakley patent (England, 1936), and the Weeks patent (1951)—the Weeks patent being the one on which Solo relies in advancing its own claim for patent infringement. The Sawyer and Coakley patents, described fully in the opinion of the court below, resulted in devices which were somewhat hampered in flexibility because the teeth were inserted into or them-

selves shaped into a fairly rigid backing. However, we need not pass on the question whether the Sawyer and Coakley patents anticipated Feathercombs' (Smith) patent, because we agree with the court below that Solo's (Weeks) patent, which broke away from the rigid-backing comb, teaches a flexible device capable of relatively free expansion and shaping of the feminine coiffure. And the differences between the Feathercombs and the earlier Weeks patent are not so great that they would not "have been obvious at the time the invention was made to a person having ordinary skill" in the haircomb art. 35 U. S. C. §103.

The court below also found that the Weeks patent, applied for in 1948, issued in 1951, and purchased by Solo in 1958 (after Feathercombs had commenced its action for patent infringement), was invalid for anticipation and lack of novelty. The comb referred to by the Weeks patent is made of plastic, or other flexible material, and consists of a series of serpentine portions, a device capable of relatively full expansion and contraction. Judge Metzner held that the Weeks patent taught little that could not be derived from the earlier Sawyer and Coakley patents. Here too, we need not make a determination for it is clear that the Weeks patent was anticipated by an even earlier patent issued in 1894 to one Nathan Rheinberg. The Rheinberg comb was formed of a wire bent in zigzag form so as to make a series of rows of teeth. Unlike the Sawyer and Coakley hair-retainers, it was without any spine and was obviously expandable; hence Weeks' innovations in the haircomb art lack the novelty requisite to patent.[1] We therefore affirm the judgment of the lower court in finding both the Smith and Weeks patents invalid.

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[1] Solo claims that the Rheinberg patent was not formally introduced in evidence and was not passed on by the court below; it therefore contends that Feathercombs cannot rely on that patent on its appeal. We think, however, that United States patents

Appendix A

II.

Solo has long been known as a manufacturer of various hair accessories for women, such as combs, curlers and hairnets. In advertising and marketing its products Solo often inserted a short descriptive or suggestive word between its trademark "Solo" and the noun identifying the product. "Solo Grip-Tite-Tuk Combs," "Solo Sleep Easy Curlers," and "Solo Comfy Curlers" are examples. These terse and contrived adjectives were not used in any trademark sense, but were merely words descriptive of the particular qualities of the hair product. From 1938 to 1957, Solo used the term "Featherlight" in conjunction with its hair roller. The court below found, and properly so, that this word too was merely used to describe the qualities of Solo's hair roller, and was not used in a trademark sense. That is, the word "Featherlight" was not meant to convey to the public the fact that the product was manufactured by a particular company and was not indicative of source. A mere examination of Solo's advertising in the period

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may be judicially noticed. It has always been clear that courts may take judicial notice of elements in the prior art which are of universal notoriety. *Brown* v. *Piper*, 91 U. S. 37, 43 (1875); Amdur, *Patent Law and Practice* 840-42 (1935). There has been some conflict in authority regarding notice of particular patents, but we approve the view adopted in *Tolfree* v. *Wetzler*, 22 F. 2d 214, 216 (D. N. J. 1927), rev'd on other grounds, 25 F. 2d 553 (3d Cir.), cert. denied, 278 U. S. 628 (1928), that such notice is proper in the discretion of the court. The *Tolfree* opinion noted the contrary authority, but chose to adopt a more liberal rule. We are likewise persuaded by the analogy of patent records to ordinary reports of other executive departments, which are clearly subject to judicial notice. See *Tenipel* v. *United States*, 248 U. S. 121 (1918). Judicial notice of the Rheinberg patent is made yet more appropriate by the fact that it presents evidence merely cumulative to that adduced and made the basis of the court's judgment below. Moreover, Solo itself, proponent of the Weeks patent, notes the Rheinberg patent in its answer as a defense to Featherecombs' action for patent infringement.

between 1938 and 1957 bolsters this conclusion, for the word "Solo" in block-letters was given great prominence in the display of the hair roller, while the word "Featherlight" was depicted in much smaller block lettering.

Feathercombs came upon the scene in 1953, when it began to merchandise its expandable hair retaining comb under the trademark "Feathercombs" appearing in black script on white display cards. This mark was granted registration in the principal register for distinctive marks on January 1, 1957. From the date of its entry upon the market, Feathercombs' expandable comb, as well as its trademark, were given wide publicity in unsolicited articles and editorials in newspapers and in popular and fashion magazines. In 1957, more than four years after Feathercombs first met with success in the hair-retaining art, Solo marketed an almost identical comb, denoting it the "Featherlight Comb." The word "Solo" which was generally prefixed to the name of that company's hair products, was conspicuously absent from its usual position in the display material presenting the comb to the public. The words "Featherlight Combs" appeared at the top of the card upon which the comb was affixed, and the word "Solo" appeared in an oval at the bottom corner of the card. Also absent from the card was Solo's familiar red and yellow background; like Feathercombs' display card, Solo's was white. In 1958, Solo applied for, but was denied registration in the principal register for the term "Featherlight." The word was subsequently (March 10, 1959) granted registration in the supplemental register, which is reserved for marks that are merely descriptive. The registration of "Featherlight" was granted for "Hair Rollers and Combs."

Appendix A

Solo admits[2] that the terms "Feathercombs" and "Featherlight" are likely to cause confusion among ordinary purchasers of the parties' hair appliances. The court below found that such confusion was *in fact* created because of the similarity of trademarks, marketing practices and the advertising and display materials. We are therefore confronted with the problem of which, if either, of the parties before the court is entitled to the free use of its trademark and to an injunction against the infringing trademark use of the other.

We agree with the court below that Solo has infringed the trademark "Featherombs" by its post-1957 use of the word "Featherlight" in merchandising its expandable comb. Solo contends that its use of the word "Featherlight" before 1953, when Featherombs first marketed its comb, was not merely descriptive but was a valid trademark which indicated the source of the product. It is elementary that in order to acquire a right to the exclusive use of a mark, it must be such as to identify the origin of a product or service and to distinguish one product or service from another. Vandenburgh, *Trademark Law and Procedure* 1 (1959). In contending that the word "Featherlight" did (before 1953) connote the source of the hair product on which it was used, Solo refers to *Charles of the Ritz, Inc.* v. *Elizabeth Arden Sales Corp.*, 161 F. 2d 234 (C. C. P. A. 1947) where the registered mark "Feather-Light" was held to be a valid trademark for face cream, and the court refused to cancel it as "merely descriptive." The case fails to support Solo's contention. It highlights the essential distinction that must be made betwen marks that are suggestive and those that are "merely descriptive." The former are good trademarks. Vandenburgh, *op. cit. supra*, §4.30, at 69. In *Charles of the Ritz* the word "Feather-Light"

[2] Paragraph 16 of its Answer.

was held to be "highly suggestive" as to the qualities of the plaintiff's face cream; it was not deemed to be "merely descriptive" of the weight or appearance of the plaintiff's product. In the present case, however, the court below concluded, and with ample support in the evidence, that the word "Featherlight," as applied to hair rollers, merely described a quality of the metallic basic appliance, a quality that would make it desirable to the consumer.

More in point is the case of *In re Federal Cement Tile Co.*, 58 F. 2d 457 (C. C. P. A. 1932). There the court affirmed the decision of the Commissioner of Patents in refusing registration of the word "Featherweight" as a trademark for use on concrete roof slabs. The court found the marks merely descriptive of the character and quality of the goods. "[W]e can conceive of no impression which an observer would derive from seeing the word on such article except the impression that, comparatively speaking, the article was of very light weight." *Id.*

Since the pre-1953 use of the word "Featherlight" was merely descriptive and did not develop that secondary meaning indicative of source which would be necessary to grant it judicial protection as a valid trademark, use of the word "Feathercombs" was not an infringement of Solo's mark. On the other hand the court below properly held that the word "Feathercombs" did constitute a valid trademark. "Feathercombs," as the trial court found, is not merely descriptive, but "has become widely known by the purchasing public and associated by it with Feathercombs, Inc. to indicate Feathercombs, Inc., as the source of hair-retaining devices in connection with which it is used." This finding is amply supported by the evidence of widespread publicity given to Feathercombs' hair-retainer when first brought to the attention of the public in 1953. Although a

valid trademark must serve as an indication of origin, we are not to be construed as saying that it is necessary that purchasers actually know the name of the manufacturer of the goods they purchase. "It suffices that the public normally assumes that articles bearing the same mark are from the same source." 3 Callmann, *Unfair Competition and Trade-Marks*, §84.1, at 1628 (2 ed. 1950). See *Tas-T-Nut Co.* v. *Variety Nut & Date Co.*, 245 F. 2d 3, 7 (6th Cir. 1957).

Despite the concession of both parties that the two marks here in question are likely to be misleading and confusing, Solo contends that it is not liable for the infringement of the mark "Feathercombs." It contends that although the mark may have been valid and exclusive at first, it became "generic" by Feathercombs' use of the word as a noun denoting the expandable comb itself and therefore lost any claim to protection. There is no evidence which would require us to overturn the lower court's finding that "Feathercombs" remained a valid trademark, indicative of origin. When a mark loses this function, and merely gives information as to the nature or class of an article, the holder of the mark suffers a total loss of rights in it. The mark then becomes non-distinctive, loses its secondary meaning, and becomes generic. See *Kellogg Co.* v. *National Biscuit Co.*, 305 U. S. 111 (1938); *Community of Roquefort* v. *William Faehndrich, Inc.*, 2d Cir., No. 27338 (June 6, 1962); *Bayer Co., Inc.* v. *United Drug Co.*, 272 Fed. 505 (S. D. N. Y. 1921) (L. Hand, *J.*). A mark is not generic merely because it has *some* significance to the public as an indication of the nature or class of an article. If that were so, then Feathercombs' frequent reference to its product as "the Feathercomb" might well have caused it to lose exclusive right to the work. In order to become generic the *principal* signifi-

cance of the word must be its indication of the nature or class of an article, rather than an indication of its origin. See *Community of Roquefort* v. *William Faehndrich, Inc., supra; Coca-Cola Co.* v. *Koke Co. of America*, 254 U. S. 143 (1920); *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U. S. 537, 547 (1891); Vandenburgh, *op. cit. supra*, §9.20. There is no convincing evidence that the word "Feathercombs" *primarily* had this connotation. Therefore, Solo was not free to treat its competitor's mark as generic and to disregard its exclusive claim to that mark.

Solo also contends that its use of the word "Featherlight" after 1957 must be deemed merely descriptive in accordance with the lower court's finding with respect to its earlier use of that word on hair rollers. Solo argues that it is not liable for infringement because a descriptive term cannot infringe a trademark. The court below recognized that "a purely descriptive term used descriptively cannot infringe a valid trademark," 196 F. Supp. 305; see 15 U. S. C. §1115(b)(4); but went on to hold that after 1957 Solo used the word "Featherlight" as a trademark and not merely to describe its product. No doubt an ordinarily descriptive word may, in the context of certain circumstances, take on nondescriptive or distinctive attributes and become capable of indicating source. Thus, "'a word descriptive when used in connection with one line of goods may be fanciful or suggestive in other contexts.'" 3 Callmann, *op. cit. supra*, §71.1(c) at 1083; "Featherlight" as applied to cosmetic creams is an example. So too, a descriptive word may have no relevance to any feature or characteristic of the goods in question. See *Stork Restaurant, Inc.* v. *Sahati*, 166 F. 2d 348, 355 (9th Cir. 1948). Solo's post-1957 use of "Featherlight" did not become nondescriptive for these reasons. But the word did take on

trademark characteristics because of Solo's clear attempts to give it a conspicuous position in its marketing and display techniques, without giving prominence to the mark "Solo," as it did with other of its hair appliances, more specifically its "hair rollers," its "Pony Tail Round Comb," its "Tuck Comb" and its "Bar Barrette." That Solo had intended to use the term "Featherlight" in a trademark sense is further suggested by its application in 1958 for registration in the principal register. "If a competitor of a trade-mark owner seeks registration of the mark, that would be conclusive evidence of his intent to make a trade-mark use thereof." 3 Callmann, *op. cit. supra*, §85.1(a), at 1670. For these reasons Solo cannot now justify its trademark use by contending that the term is merely descriptive.[3] Consequently, Solo has no valid defense to the claim for trademark infringement. The parties stipulated that "Featherombs" and "Featherlight" are likely to lead to confusion and the court below found that confusion in fact existed. Therefore, Judge Metzner properly issued an injunction against the use of the designations "Featherlight Combs" or "Featherlight" or any other designation confusingly similar to the mark "Featherombs." And he was also right in ordering the cancellation of the registration of "Featherlight" in the supplemental register. See 15 U. S. C. §1119. Registration in the supplemental register which is reserved for nondistinctive marks, entitles the owner of a mark to institute actions based upon it in the federal courts, see 15 U. S. C. §1121, and to obtain the remedies provided in the Lanham Act, 15 U. S. C. §§1114-22. But registration cannot give validity to a mark, the use of

[3] It is not necessary to decide whether a term used even descriptively can infringe, if purposely used in a deceptive manner or in bad faith. See 3 Callmann, *op. cit. supra*, §85.1(b).

which would be invalid at common law. Section 23 of the Lanham Act, 15 U. S. C. §1091, prohibits the registration in the supplemental register of any word which "resembles a mark registered in the Patent Office * * * or [which is] likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers * * *" See 15 U. S. C. §1052(a). The cancellation will not interfere with the lawful and purely *descriptive* use of the words "feather light" in the advertising and display of Solo's products, and will therefore not unduly hamper Solo in the marketing of its line of hair appliances.

III.

Feathercombs' claim for trademark infringement leads naturally into its broader claim of unfair competition. The court below found that Solo had made a deceptive use not only of the term "Featherlight" but also of its packaging and display materials. Before Solo began to market its expendable haircomb, Feathercombs had presented its own comb to the public by affixing it to a rectangular white card bearing, in black script, the word "Feathercombs." Cards of various sizes were gathered in a box to be placed on the display counter and attached to the box was a fairly large display card with photographs depicting the usually attractive women using the comb to shape various hair styles. At the base of the series of photographs, just above the tray containing the combs, or interspersed between rows of photographs, was found a legend such as, "Style your own hair just the way you want * * * securely * * * with Fabulous, invisible Feathercombs." In 1957, four years after Feathercombs had begun to present its product to the public in this format, Solo adopted an almost identical white backing card of various sizes, beneath a display card

containing photographs of attractive ladies using the expandable comb and a somewhat similar legend. We agree with the lower court that the confusion in trade dress combined with the infringement of the trademark, was sufficient to create considerable confusion in the eyes of the average purchasing customer.

The Feathercombs' patent being invalid, it is clear that Solo had every right to market a comb similar or identical to that marketed by its competitor. But it is also clear that the law placed upon Solo an obligation to advertise, display, and promote its product so as not to be unduly confusing to the average consumer. See *Hygienic Specialties Co.* v. *H. G. Salzman, Inc.*, 302 F. 2d 614, 619 (2d Cir. 1962). The fact that Solo abandoned its familiar red and yellow display background, dropped the trade name "Solo" from its place of usual prominence and adopted a format almost identical with Feathercombs' when it was clear that the products would be displayed near each other on merchandising counters and would attract the same group of females, is ample evidence of its intention to tread upon the good will of Feathercombs.

> "It is so easy for the honest business man, who wishes to sell his goods upon their merits, to select from the entire material universe, which is before him, symbols, marks and coverings which by no possibility can cause confusion between his goods and those of his competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his rival that the public may fail to distinguish between them." *Florence Mfg. Co.* v. *J. C. Dowd & Co.*, 178 Fed. 73, 75 (2d Cir. 1910).

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"In this circuit and others, numerous decisions have recognized that the second comer has a duty to so name and dress his product as to avoid all likelihood of consumers confusing it with the product of the first comer." *Harold F. Ritchie, Inc.* v. *Chesebrough-Pond's, Inc.*, 281 F. 2d 755, 758 (2d Cir. 1960). We note that Feathercombs, aside from its ownership of a valid trademark, has no monopoly upon any one of the improvements of its packaging and display devices. But, in determining whether there is likelihood of confusion, we must examine all of the components taken as a whole.

Solo contends, however, that Feathercombs' display did not acquire any secondary meaning and that the finding of unfair competition should be set aside. The reply to this is that there is no need for the display combination to acquire an extraordinary meaning; it need merely be distinctive enough to become recognized as "a public guaranty of origin and quality." *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 119 F. 2d 316, 322 (6th Cir. 1941), rev'd on other grounds, 316 U. S. 203 (1942); 3 Callmann, *op. cit. supra*, § 82.1 (h) at 1469. The finding of the court below that there was *actual* consumer confusion reinforces the conclusion that the Feathercombs mark and display material was in fact significant to the purchasing public.

We believe, however, that in framing his decree, Judge Metzner failed to delineate between that form of competition which is fair and that which is not. He was correct in ordering Solo to deliver up for destruction all "sales and advertising literature including packaging and display material having imprinted thereon the designation Featherlight or Featherlight Combs" or in the alternative to have these materials overprinted to delete all references to those words as an attempted trademark designation for Solo's

hair appliances. Such an injunction follows clearly from the holding of trademark infringement. But the court went on to order the destruction of all display material in Solo's control, which includes photographs of women using the flexible comb to shape various hair styles and any hortatory legend similar to that employed by Feathercombs. We believe that although the use of such material by Solo was an indication of its intention to engage in unfair competition, Feathercombs' grievance could be remedied by an injunctive provision which is less drastic and which would not deprive Solo of the right to legitimately market its own hair appliance. Since Solo infringes no patent by manufacturing its expandable comb, it is essential that it not be unduly curtailed from marketing it by being denied the usual promotional accoutrements of the modern market place. Solo must be permitted to call to the public's attention the novel uses of the expandable comb, and this can hardly be done without the use of careful hand drawings or photographs of women using the article itself. So too, Solo must be permitted to use the ordinary "puffing" language customary in the promotion of a product. The similarity of photographs and legend between Feathercombs' and Solo's display may well be necessary because of the similarity in their products. To give Feathercombs a monopoly of these display techniques would be in effect to give it a monopoly over the sale of a product not gained by its spurious patent.

> "If petitioner had been content to manufacture the preparation and let it make its own way in the field of open and fair competition, there would be nothing more to be said. It was not thus content, however, but availed itself of unfair means, either expressly or jointly, to impose its preparation on the ultimate pur

chaser as and for the product of respondent. Nevertheless, the right to which respondent is entitled is that of being protected against unfair competition, not of having the aid of a decree to create or support or assist in creating or supporting a monopoly of the sale of a preparation which everyone, including petitioner, is free to make and vend." *Warner & Co.* v. *Eli Lilly & Co.*, 265 U. S. 526, 532 (1924); see *American Chicle Co.* v. *Topps Chewing Gum, Inc.*, 210 F. 2d 680 (2d Cir. 1954).

Thus, paragraph 9 of the judgment below should be stricken. Feathercombs' display will be amply protected by paragraph 7B, which prohibits generally Solo's use of "display material deceptively similar to" that of Feathercombs.

Finally, Solo argues that the lower court erred in submitting the issue of damages and profits to a master, contending that there was no evidence of actual confusion caused by trademark infringement and unfair competition, but at best only a likelihood of confusion. We do not agree. The lower court found actual confusion and there is ample support for the finding in the record. Therefore, we need not address ourselves to the problem of damages for mere likelihood of confusion.

The judgment below, as modified in accordance with this opinion as it relates to Solo's acts of unfair competition, is affirmed.

APPENDIX B

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the thirteenth day of July, one thousand nine hundred and sixty two.

Present:

HON. HENRY J. FRIENDLY,
HON. IRVING R. KAUFMAN,
HON. PAUL R. HAYS,

Circuit Judges.

FEATHERCOMBS, INC.,

Plaintiff-Appellant,

—v.—

SOLO PRODUCTS CORPORATION,

Defendant-Appellee.

SOLO PRODUCTS CORPORATION,

Plaintiff-Appellant,

—v.—

FEATHERCOMBS, INC.,

Defendant-Appellee.

Appendix B

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Southern District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed as modified in accordance with the opinion of this court.

A. DANIEL FUSARO
Clerk

APPENDIX C

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the twenty-fifth day of July, one thousand nine hundred and sixty two.

Present:

HONORABLE IRVING R. KAUFMAN,
HONORABLE PAUL R. HAYS,
Circuit Judges.

FEATHERCOMBS, INC.,

Plaintiff-Appellant,

—v.—

SOLO PRODUCTS CORPORATION,

Defendant-Appellee.

SOLO PRODUCTS CORPORATION,

Plaintiff-Appellant,

—v.—

FEATHERCOMBS, INC.,

Defendant-Appellee.

Appendix C

A motion having been made herein by counsel for the appellant to extend the time to file a petition for rehearing to 40 days from July 29, 1962.

Upon consideration thereof, it is

ORDERED that said motion be and it hereby is denied.

A. DANIEL FUSARO
Clerk

APPENDIX D

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the sixth day of August, one thousand nine hundred and sixty two.

Present:

HONORABLE IRVING R. KAUFMAN,
HONORABLE PAUL R. HAYS,

Circuit Judges.

FEATHERCOMBS, INC.,

Plaintiff-Appellant,

—v.—

SOLO PRODUCTS CORPORATION,

Defendant-Appellee.

SOLO PRODUCTS CORPORATION,

Plaintiff-Appellant,

—v.—

FEATHERCOMBS, INC.,

Defendant-Appellee.

A motion having been made herein by counsel for the defendant-appellant, Solo Products Corporation, to stay

Appendix D

the issuance of the mandate pending application for a writ of certiorari to the Supreme Court of the United States.

Upon consideration thereof, it is

ORDERED that said motion be and it hereby is granted in accordance with the provisions of Rule 28(C) of the rules of this Court.

A. DANIEL FUSARO
Clerk

by VINCENT D. CAULIN
Chief Deputy Clerk

APPENDIX E

Statutes Involved

Patent Act, 35 U. S. C. 282:

§ 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the

prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

Trademark Act of 1946, 15 U. S. C.

Section 1052. Trademarks registrable on the principal register

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(d) consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers: • • •

Section 1091. The Supplemental Register

Marks registrable on. In addition to the principal register, the Commissioner shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal

register herein provided, except those declared to be unregistrable under paragraphs (a), (b), (c), and (d) of section 2 of this Act, which have been in lawful use in commerce by the proprietor thereof, upon or in connection with any goods or services for the year preceding the filing of the application may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of section 1 so far as they are applicable.

Examination of application. Upon the filing of an application for registration on the supplemental register and payment of the fee herein provided the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 12 of this Act shall apply.

Nature of mark. For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, or device or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

Mark used in foreign commerce. Upon a proper showing by the applicant that he has begun the lawful use of his mark in foreign commerce and that he requires domestic registration as a basis for foreign protection of his mark, the Commissioner may waive the requirement of a full year's use and may grant registration forthwith.

Appendix E

Sec. 1094. Supplemental Register—Provisions of Act applicable

The provisions of this Act shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 2 (e), 2 (f), 7 (b), 12 (a), 13 to 18, inclusive, 22, 33, and 42 of this Act.

APPENDIX F

United States Patent Office

639,413
Registered Jan. 1, 1957

PRINCIPAL REGISTER
Trademark

Ser. No. 9,714, filed June 6, 1956

Feathercombs

Feathercombs, Inc. (New York corporation)
137 E. 57th St.
New York 22, N. Y.

For: RETAINERS AND COMBS FOR HAIR AND DECORATIVE HAIR RETAINERS, in CLASS 40.
First use Aug. 19, 1953; in commerce Oct. 1, 1953